Remarks

The Office Action mailed November 3, 2005, has been carefully reviewed and the foregoing amendments have been made in consequence thereof.

Claims 2-13 and 39-64 are pending in this application. Claims 2-13 and 39-64 stand rejected. Claims 7, 46 and 58 are canceled herein. Claims 3, 6, 39, 40, 42, 44, 52, 54, 57 and 64 are amended herein. No new matter has been added.

The objection to Claim 39 under 35 U.S.C. § 132(a) as containing new matter is respectfully traversed.

The Office Action asserts that the third, fifth and sixth steps recited in Claim 39 are not supported by the original disclosure. The third step of Claim 39 is amended herein. The sixth step follows from the fifth step of linking the customized template to the at least one hierarchy of entities for restricting access to the customized template.

Regarding the fifth step, the Office Action quotes paragraphs [0305] and [0306] and notes that it's not clear whether the term "attach" reads over "linking" function or which could mean "hyperlink" in a web page. Paragraph [00134] of the originally filed specification describes a user online with a server 10. "The user has the online capability to prompt server 10 for a web page user interface providing pull-down menu 32. Paragraph [00135] of the originally filed specification describes pull-down menu 32 as "including individual major tabs for user profiles.....and **entities**." These tabs allow a user to select "one or more template related tabs whereby a user can create a template from a web interface provided by server 10 which can accommodate business metric data." Paragraph [00135] of the originally filed specification also describes "selection of a tab by a user causes server 10 to accept instruction from the user and server 10 retrieves a web page for the user and supplies that web page to the user." Hypertext is, generally, any text that contains links to other documents – words or phrases in the document that, when selected by a user, causes another document to be retrieved and displayed. Thus, because each tab functions as hypertext, one of ordinary skill in the art would understand that each tab constitutes a link or a hyperlink to and between templates. The Examiner is respectfully directed to MPEP section 2141.03. MPEP section 2141.03 indicates that the "hypothetical"

person having ordinary skill in the art to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art.

Paragraph [00175] of the originally filed specification describes a web page "user interface whereby a user may create new **entities** which may include business parent business child relationships." Thus, paragraph [00175] implies that **entity** templates may be created and organized in a hierarchical structure in server 10. Moreover, Figure 42 discloses the hierarchical relationship between each business unit. Because each tab functions as a hyperlink to and between **entity** templates and **entity** templates may be organized in a hierarchical structure, the customized templates are linked to the at least one hierarchy of **entities**. Accordingly, by virtue of linking the template to the hierarchy of **entities**, the data fields of each template are also linked to the hierarchy of **entities**.

Paragraph [00114] describes creating a "hierarchy of **entities** and **attach** them to his/her template." **As explained above, each template is linked to the at least one hierarchy of entities.** Thus, as used in the original application **"attach"** is intended to mean a link or a hyperlink. Consequently, the specification provides adequate support for the recitations of steps five and six of Claim 39.

For at least the reasons set forth above and having provided support for the features noted in the Office Action, Applicants respectfully request that the objection to Claim 39 under 35 U.S.C. § 132(a) be withdrawn.

The objection to Claims 7, 46 and 58 are respectfully traversed. Claims 7, 46 and 58 have been canceled. Accordingly, Applicants respectfully request that the objection to Claims 7, 46 and 58 be withdrawn.

The rejection of Claims 2-6, 8-13, 39-45, 47-57, and 59-64 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Applicants respectfully submit that Claims 2-6, 8-13, 39-45, 47-57, and 59-64 satisfy Section 112, second paragraph. More specifically, Applicants respectfully submit that Claims 2-6, 8-13, 39-45, 47-57, and 59-64 are definite and particularly point out and distinctly claim the subject matter of the invention.

The Office Action asserts that in Claim 39, it's not clear the relationship between the "one client system" and "the 2nd user". Applicants respectfully traverse this assertion. Applicants, however, submit that Claims 39, 40, 52 and 64 have been amended to address this rejection.

The Office Action asserts that in Claim 39, lines 13-14, the phrase "to link at least one of a level and a weight to a data field displayed on the customized template" is vague and indefinite because as shown in Fig. 9, [00153], "weight" or "level" is the "subheading" or "title" of a column of a business metric or parameter, so the linking deals with a metric "target" with a "field" of a template. Applicants respectfully traverse this rejection. Applicants, however, submit that claims 39, 40, 52, and 64 have been amended to address this rejection.

The Office Action asserts that in Claim 39, lines 24-36, "which involves the second user enters 'business metrics' into the 'data fields' displayed on the customized template, this is vague because it appears that data (numbers or text) about business metrics are entered in the 'data fields'." Applicants respectfully traverse this rejection. Applicants, however, submit that claims 3, 6, 39, 40, 42, 44, 52, 54, 57 and 64 have been amended to address this rejection.

The Office Action also asserts that "it's not clear the relationship between steps (b)-(f) with respect to creating a customized template by a first user and steps (g)-(j) for managing business metrics by a second user." The Office Action indicates that "there are no claim limitations with respect to (1) 'one of a level and a weight' and (2) 'the hierarchy of entities in steps (g)-(j)'. The Office Action further indicates that "the scope of the claim dealing with a method for managing business metrics for a business entity, therefore, only limitations that fulfills the scope of the claim carry patentable weight, anything else in the claim would just being presence there but carry no patentable weight including limitations with respect to creating a template." Applicants respectfully traverse this rejection.

The features as recited in Claim 39 relating to "creating a template" are essential features of Claim 39 as written. The Examiner is respectfully directed to MPEP sections 2131 and 2143.03. MPEP section 2131 indicates that to anticipate a claim, a reference must teach each and every element of a claim. MPEP section 2143.03 indicates that all claim limitations must be taught or suggested by the prior art to establish prima facia obviousness of a claimed invention.

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Consequently, Examiners are not permitted to arbitrarily decide which features of a claim are considered for examination, and which features of a claim are not considered for examination. The Examiner must consider each claim as a whole.

The Office Action asserts that in Claim 39, "its not clear how the last step creating reports with so many features while in the inputting step, step (g), the second user only enters business data or business metrics?" Applicants respectfully traverse this rejection. Applicants submit that the data about the business metrics may be presented in many different types of reports to evaluate the performance of companies.

The Office Action asserts that Claim 3 "is vague and indefinite because it calls for a further limitation on step '(j) generating a plurality of reports further comprise' but the 2 steps deal with '(k) performing a mathematical computation' and (l) 'generating a trend analysis' are not related to the generating the report. In other word, its not clear how the generating the computation or trend analysis further limit the step of 'generating a report'. Also, it not clear the relationship of between steps (k) and (l)." Applicants respectfully traverse this rejection. Applicants, however, submit that claims 3, 42, and 54 have been amended to address this rejection.

For at least the reasons set forth above, Applicants respectfully request that the rejections of Claims 2-6, 8-13, 39-45, 47-57, and 59-64 under 35 U.S.C. § 112, second paragraph, be withdrawn.

The rejection of Claims 39, 2-13, 40-51, 52-63, and 64 under 35 U.S.C. § 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (or AAPA) in view of (2) Bernardo et al. (U.S. Patent No. 6,684,369) ("Bernardo") and (3) Fleming et al. (U.S. Patent Publication 2002/0059264) ("Fleming") is respectfully traversed. Because the Examiner rejected all of the independent claims, namely Claims 39, 40, 52, and 64, together, Applicants have structured the following arguments using the same format.

The Office Action asserts that "Claims 39, 40, 52, and 64 appear to have two scopes:

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(1)   creating a customized template by a first user for use on a client system which are covered by steps (a)-(f), and

(2)   using the created template by the first user for managing the business metrics by a second user on a client system as shown by steps (g)-(j)."

The features as recited in Claims 39, 40, 52 and 64 relating to "creating a template" are essential features of Claims 39, 40, 52 and 64, respectively, as written. The Examiner is respectfully directed to MPEP sections 2131 and 2143.03. MPEP section 2131 indicates that to anticipate a claim, a reference must teach each and every element of a claim. MPEP section 2143.03 indicates that all claim limitations must be taught or suggested by the prior art to establish prima facia obviousness of a claimed invention. Consequently, Examiners are not permitted to arbitrarily decide which features of a claim are considered for examination, and which features of a claim are not. The Examiner is required to consider each claim as a whole. Applicants respectfully request examination of Claims 2-6, 8-13, 39-45, 47-57 and 59-64, accordingly.

Applicants respectfully submit that no combination of AAPA, Bernardo and Fleming describes or suggests the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that none of AAPA, Bernardo, or Fleming, alone or in combination, describe or suggest a method (Claim 39), a network based system (Claim 40), an apparatus (Claim 52), or a computer program (Claim 64), for managing business metrics for a business entity using a server system coupled to a database and at least one client system, the business entity having a plurality of business units, the method comprising the steps of: storing in the database a plurality of web pages including a create template web page; prompting a first user to create a customized template for receiving business metrics by displaying at the at least one client system the create template web page, the create template web page prompts the first user to enter data including at least one of a template name, a frequency, a first due date, a contact name, and a template description, the create template web page prompts the first user to define data fields to be displayed on the customized template and a type of business metrics to be entered into the customized template, the customized template is stored within the database for retrieval by a second user for inputting business metrics; and, *prompting*

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*the first user to link a metric target with a data field displayed on the customized template,
wherein the metric target is at least one of a level and a weight.*

Moreover, Applicants submit that none of AAPA, Bernardo, or Fleming, alone or in combination, describe or suggest a method for managing business metrics for a business entity including creating at least one hierarchy of entities within the business entity including storing within the database a relationship between each of the business units included within the business entity; linking the customized template to the at least one hierarchy of entities for restricting access to the customized template to only selected business units included within the business entity; linking the data fields included within the customized template to the at least one hierarchy of entities for combining data for a plurality of selected business units included within the business entity; displaying the customized template at the at least one client system to prompt the second user to enter business metrics relating a business unit linked to the customized template, the second user enters business metrics into the data fields displayed on the customized template; storing the business metrics in the database; analyzing the business metrics stored in the database using the server system; and, generating, using the server, a plurality of reports including a first report showing business metrics for each business unit linked to the customized template including each business unit having entered data and the hierarchical relationship between each business unit, and a second report containing desired combinations of business metrics entered into linked data fields for each business unit linked to the customized template based on the hierarchy of entities.

AAPA discloses that capturing, analyzing, reporting and assessing business metrics can be highly valued business management tools. Additionally, AAPA discloses, the availability of a readily customizable spreadsheet for each of several business units is a major advantage to that business unit because this may result in capture of needed valuable business metric data thereby enhancing analysis and reporting and business management capability.

Bernardo discloses a tool, system and method for creating Web sites. More specifically, Bernardo discloses a library of templates (e.g., text, fields, HTML code and formulas) that correspond to the available features and options. The templates comprise databases which may include fields, forms, views, text, formulas and profiles that enable customization of the features.

There are fields for company name, address, contact person, etc. The user may be prompted to select whether to create a new site or edit an existing one. Features of each Web page include formatting options, security links, colors, borders, buttons, workflow commands, graphics, backgrounds, text, and other items. Some features may be required and some may be discretionary. The templates may be stored in a database 40 associated with server 30. A page may also contain various links to other files. For example, the link may include a uniform resource locator that may link to another Web page. A page may include various fields in which text may be entered to customize the resulting Web page without writing HTML or other code. A library of Help documents are associated with the templates. The help documents include fields that link the document with one or more related fields of other templates to associate each help document with one or more features and/or fields.

Fleming discloses a method for presenting data derived from one or more databases. A business model maps the data that can be requested by a user to the data contained in databases 2914. The databases may be spread across multiple enterprises or corporations 2902, 2904, and 2908. Monitors are built using templates, so customers are able to rapidly customize their look and feel to suit their particular requirements. Additionally, since monitors 3102 are easily customized, business data can be properly presented, in real time, to all levels of client users, allowing them to take quick action when problems arise. The monitors are created around trend markers 3104, which provide a graphical display of a trend of business data over time. By managing these trend markers 3104, client users can quickly avert problems before they affect the financial performance of the company. By selecting trend symbol 3104, the end user 206 will be provided detailed information related to the selected trend symbol. This detailed information may also have trend symbols which allow a user to visually narrow the reasons for trend changes of the originally selected trend symbol. Trend markers 3104 may be based on a mathematical function which is associated with, but not limited to, a plurality of categories or indicators. In various embodiments the trend markers 3104 indicate whether information displayed has exceeded a threshold, or changed over a period of time. Upon a user query, the value of a derived indicator or category is calculated by a model manager using the associated formula. Within a library 3801, collections 3803 are made up of one or more reports 3805. Each report 3805 is associated with a set of administrator defined categories and indicators, which a

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user may select to form a page. A report 3805 may contain a plurality of pages 3807. When a report 3805 is selected by a user, the report's 3805 underlying pages 3807 are displayed.

None of AAPA, Bernardo, or Fleming, considered alone or in combination describe or suggest a method, network, apparatus, or computer program for managing business metrics as recited in Claims 39, 40, 52, and 64, respectively. Specifically, neither AAPA, Bernardo, or Fleming, considered alone or in combination, describe or suggest a method for managing business metrics for a business entity that includes *prompting the first user to link a metric target with a data field displayed on the customized template, wherein the metric target is at least one of a level and a weight.* Rather, AAPA discloses capturing, analyzing, reporting and assessing business metrics; Bernardo discloses inputting data to construct a web page; and, Fleming discloses a method for presenting business data using a computer system wherein there may exist a parameter which is derivable from the business data and not necessarily pre-existing in the business data. Accordingly, none of AAPA, Bernardo, or Fleming, considered alone or in combination, describe or suggest a method for managing business metrics for a business entity using a server system coupled to a database and at least one client system, the business entity having a plurality of business units, said method comprising the steps of: storing in the database a plurality of web pages including a create template web page; prompting a first user to create a customized template for receiving business metrics by displaying at the at least one client system the create template web page, the create template web page prompts the first user to enter data including at least one of a template name, a frequency, a first due date, a contact name, and a template description, the create template web page prompts the first user to define data fields to be displayed on the customized template and a type of business metrics to be entered into the customized template, the customized template is stored within the database for retrieval by a second user for inputting business metrics; and, *prompting the first user to link a metric target with a data field displayed on the customized template, wherein the metric target is at least one of a level and a weight.*

Moreover, Applicants submit that none of AAPA, Bernardo, or Fleming, alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity including creating at least one hierarchy of entities within the business entity including storing within the database a relationship between

each of the business units included within the business entity; linking the customized template to the at least one hierarchy of entities for restricting access to the customized template to only selected business units included within the business entity; linking the data fields included within the customized template to the at least one hierarchy of entities for combining data for a plurality of selected business units included within the business entity; displaying the customized template at the at least one client system to prompt the second user to enter business metrics relating a business unit linked to the customized template, the second user enters business metrics into the data fields displayed on the customized template; storing the business metrics in the database; analyzing the business metrics stored in the database using the server system; and, generating, using the server, a plurality of reports including a first report showing business metrics for each business unit linked to the customized template including each business unit having entered data and the hierarchical relationship between each business unit, and a second report containing desired combinations of business metrics entered into linked data fields for each business unit linked to the customized template based on the hierarchy of entities. For at least the reasons set forth above, Claims 39, 40, 52, and 64 are submitted to be patentable over AAPA, Bernardo, and Fleming.

Furthermore, dependent Claims 8, 48, and 60 recite, and Claim 64 further recites, that *the level indicates higher or lower desirable features or ratings*. None of AAPA, Bernardo, or Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics as recited in Claims 8, 48, 60, and 64. Specifically, neither AAPA, Bernardo, or Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity wherein *the level indicates higher or lower desirable features or ratings*. Rather, AAPA discloses capturing, analyzing, reporting and assessing business metrics; Bernardo discloses inputting data to construct a web page; and, Fleming discloses a method for presenting business data using a computer system wherein there may exist a parameter which is derivable from the business data and not necessarily pre-existing in the business data. Accordingly, none of AAPA, Bernardo, or Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity wherein *the level indicates higher or lower desirable features or*

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ratings. For the reasons set forth above, at least Claims 8, 48, 60, and 64 are submitted to be patentable over AAPA, Bernardo, and Fleming.

When the recitations of Claims 2-6 and 8-13, 41-45 and 47-51, and 53-57 and 59-63 are considered in combination with the recitations of Claims 39, 40 and 52, respectively, Applicants submit that dependent Claims 2-6, 8-13, 41-45, 47-51, 53-57 and 59-63 likewise are patentable over AAPA, Bernardo, and Fleming.

For at least the reasons set forth above, it is respectfully requested that the rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 under 35 U.S.C. § 103(a) as being unpatentable over the combination of AAPA, Bernardo, and Fleming be withdrawn.

In addition to the arguments set forth above, Applicants further submit that the Section 103 rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify AAPA using the teachings of Bernardo and Fleming. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the

present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

None of AAPA, Bernardo or Fleming, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Because there is no teaching, suggestion, or motivation for the combination of Lewis and Park, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 be withdrawn.

Moreover, MPEP section 2143.03 indicates that all claim limitations must be taught or suggested by the prior art to establish prima facia obviousness of a claimed invention. Examiner has arbitrarily decided to disregard features of the claims directed towards creating a template. According to MPEP section 2143.03, Examiners are not permitted to arbitrarily decide which features of a claim are considered for examination, and which features of a claim are not. The Examiner is required to consider each claim as a whole. Applicants respectfully request examination of Claims 2-6, 8-13, 39-45, 47-57 and 59-64, accordingly.

The rejection of Claims 39, 2-13, 40-51, 52-63, and 64 under 35 U.S.C. § 103(a) as being unpatentable over (1) Applicant Admitted Prior Art (or AAPA) in view of (2) Fleming et al. (U.S. Patent Publication 2002/0059264) ("Fleming") is respectfully traversed. Because the Examiner rejected all of the independent claims, namely Claims 39, 40, 52, and 64, together, Applicants have structured the following arguments using the same format.

The Office Action asserts that "Claims 39, 40, 52, and 64 appear to have two scopes:

(3)   creating a customized template by a first user for use on a client system which are covered by steps (a)-(f), and

(4)   using the created template by the first user for managing the business metrics by a second user on a client system as shown by steps (g)-(j)."

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The Office Action further asserts that "since the scope of the invention dealing with managing business metrics of the second scope, the limitations with respect to how the template is created as shown in the first scope appear to be irrelevant, thus receiving no patentable weight."

The features as recited in Claims 39, 40, 52 and 64 relating to "creating a template" are essential features of Claims 39, 40, 52 and 64, respectively, as written. The Examiner is respectfully directed to MPEP sections 2131 and 2143.03. MPEP section 2131 indicates that to anticipate a claim, a reference must teach each and every element of a claim. MPEP section 2143.03 indicates that all claim limitations must be taught or suggested by the prior art to establish prima facia obviousness of a claimed invention. Consequently, Examiners are not permitted to arbitrarily decide which features of a claim are considered for examination, and which features of a claim are not. The Examiner is required to consider each claim as a whole. Applicants respectfully request examination of Claims 2-6, 8-13, 39-45, 47-57 and 59-64, accordingly.

Applicants respectfully submit that no combination of AAPA and Fleming describes or suggests the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that neither AAPA nor Fleming, alone or in combination, describe or suggest a method (Claim 39), a network based system (Claim 40), an apparatus (Claim 52), or a computer program (Claim 64), for managing business metrics for a business entity using a server system coupled to a database and at least one client system, the business entity having a plurality of business units, the method comprising the steps of: storing in the database a plurality of web pages including a create template web page; prompting a first user to create a customized template for receiving business metrics by displaying at the at least one client system the create template web page, the create template web page prompts the first user to enter data including at least one of a template name, a frequency, a first due date, a contact name, and a template description, the create template web page prompts the first user to define data fields to be displayed on the customized template and a type of business metrics to be entered into the customized template, the customized template is stored within the database for retrieval by a second user for inputting business metrics; and, *prompting the first user to link a*

metric target with a data field displayed on the customized template, wherein the metric target is
at least one of a level and a weight.

Moreover, Applicants submit that neither AAPA nor Fleming, alone or in combination, describe or suggest a method for managing business metrics for a business entity including creating at least one hierarchy of entities within the business entity including storing within the database a relationship between each of the business units included within the business entity; linking the customized template to the at least one hierarchy of entities for restricting access to the customized template to only selected business units included within the business entity; linking the data fields included within the customized template to the at least one hierarchy of entities for combining data for a plurality of selected business units included within the business entity; displaying the customized template at the at least one client system to prompt the second user to enter business metrics relating a business unit linked to the customized template, the second user enters business metrics into the data fields displayed on the customized template; storing the business metrics in the database; analyzing the business metrics stored in the database using the server system; and, generating, using the server, a plurality of reports including a first report showing business metrics for each business unit linked to the customized template including each business unit having entered data and the hierarchical relationship between each business unit, and a second report containing desired combinations of business metrics entered into linked data fields for each business unit linked to the customized template based on the hierarchy of entities.

AAPA is described above. Fleming is described above.

Neither AAPA nor Fleming, considered alone or in combination describe or suggest a method, network, apparatus, or computer program for managing business metrics as recited in Claims 39, 40, 52, and 64, respectively. Specifically, neither AAPA nor Fleming, considered alone or in combination, describe or suggest a method for managing business metrics for a business entity that includes *prompting the first user to link a metric target with a data field displayed on the customized template, wherein the metric target is at least one of a level and a weight.* Rather, AAPA discloses capturing, analyzing, reporting and assessing business metrics, and Fleming discloses a method for presenting business data using a computer system wherein

there may exist a parameter which is derivable from the business data and not necessarily pre-existing in the business data. Accordingly, neither AAPA nor Fleming, considered alone or in combination, describe or suggest a method for managing business metrics for a business entity using a server system coupled to a database and at least one client system, the business entity having a plurality of business units, said method comprising the steps of: storing in the database a plurality of web pages including a create template web page; prompting a first user to create a customized template for receiving business metrics by displaying at the at least one client system the create template web page, the create template web page prompts the first user to enter data including at least one of a template name, a frequency, a first due date, a contact name, and a template description, the create template web page prompts the first user to define data fields to be displayed on the customized template and a type of business metrics to be entered into the customized template, the customized template is stored within the database for retrieval by a second user for inputting business metrics; and, *prompting the first user to link a metric target with a data field displayed on the customized template, wherein the metric target is at least one of a level and a weight.*

Moreover, Applicants submit that neither AAPA nor Fleming, alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity including creating at least one hierarchy of entities within the business entity including storing within the database a relationship between each of the business units included within the business entity; linking the customized template to the at least one hierarchy of entities for restricting access to the customized template to only selected business units included within the business entity; linking the data fields included within the customized template to the at least one hierarchy of entities for combining data for a plurality of selected business units included within the business entity; displaying the customized template at the at least one client system to prompt the second user to enter business metrics relating a business unit linked to the customized template, the second user enters business metrics into the data fields displayed on the customized template; storing the business metrics in the database; analyzing the business metrics stored in the database using the server system; and, generating, using the server, a plurality of reports including a first report showing business metrics for each business unit linked to the customized template including each business unit having entered data

and the hierarchical relationship between each business unit, and a second report containing desired combinations of business metrics entered into linked data fields for each business unit linked to the customized template based on the hierarchy of entities. For at least the reasons set forth above, Claims 39, 40, 52, and 64 are submitted to be patentable over AAPA and Fleming.

Furthermore, dependent Claims 8, 48, and 60 recite, and Claim 64 further recites, that *the level indicates higher or lower desirable features or ratings*. Neither AAPA or Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics as recited in Claims 8, 48, 60, and 64. Specifically, neither AAPA nor Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity wherein *the level indicates higher or lower desirable features or ratings*. Rather, AAPA discloses capturing, analyzing, reporting and assessing business metrics, and Fleming discloses a method for presenting business data using a computer system wherein there may exist a parameter which is derivable from the business data and not necessarily pre-existing in the business data. Accordingly, neither AAPA nor Fleming, considered alone or in combination, describe or suggest a method, network, apparatus, or computer program for managing business metrics for a business entity wherein *the level indicates higher or lower desirable features or ratings*. For the reasons set forth above, at least Claims 8, 48, 60, and 64 are submitted to be patentable over AAPA and Fleming.

When the recitations of Claims 2-6 and 8-13, 41-45 and 47-51, and 53-57 and 59-63 are considered in combination with the recitations of Claims 39, 40 and 52, respectively, Applicants submit that dependent Claims 2-6, 8-13, 41-45, 47-51, 53-57 and 59-63 likewise are patentable over AAPA and Fleming.

For at least the reasons set forth above, it is respectfully requested that the rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 under 35 U.S.C. § 103(a) as being unpatentable over the combination of AAPA and Fleming be withdrawn.

In addition to the arguments set forth above, Applicants further submit that the Section 103 rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 is not a proper rejection. Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary

skill in the art to modify AAPA using the teachings of Fleming. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.
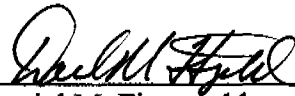
Neither AAPA not Fleming, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Because there is no teaching, suggestion, or motivation for the combination of Lewis and Park, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 2-6, 8-13, 39-45, 47-57 and 59-64 be withdrawn.

Moreover, MPEP section 2143.03 indicates that all claim limitations must be taught or suggested by the prior art to establish prima facia obviousness of a claimed invention. Examiner has arbitrarily decided to disregard features of the claims directed towards creating a template.

According to MPEP section 2143.03, Examiners are not permitted to arbitrarily decide which features of a claim are considered for examination, and which features of a claim are not. The Examiner is required to consider each claim as a whole. Applicants respectfully request examination of Claims 2-6, 8-13, 39-45, 47-57 and 59-64, accordingly.

In view of the foregoing amendments and remarks, all the Claims now active in the application are believed to be in condition for allowance. Favorable action is respectfully solicited.

Respectfully Submitted,

Daniel M. Fitzgerald
Reg. No. 38,880
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070